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REMARKS

Claims 1-22 and 35 and 36 have been cancelled herewith, without prejudice.

Claims 23-34 are pending.

Claims 11-13 stand in conflict with Claims 1-3 and 6 of Application Serial No 09//806,274. Applicant respectfully submits Claims 11-13 have been cancelled herewith.

Claims 23-31 of this application stand in conflict with claims 8-10 of Application Serial No. 09/806,274. Applicant respectfully submits claims 8-10 of Application Serial No. 09/806,274 have been previously cancelled.

Pursuant to the Examiner's request on page three, paragraph 1, Applicant states that the Applicant is the same inventor on both the instant application and Application Serial No. 09/806,274, and that there is only one Applicant on both cases.

Claims 11-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully submits this rejection has been rendered moot in light of the cancellation of Claims 11-22 herewith. Applicant requests withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102(b)

Claims 22-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,930,906 to Hemphill. Applicant respectfully traverses the rejection and requests withdrawal of same.

Applicant's invention provides a kit for measuring volatile organic compounds (VOCs) of material produced in a process system having emissions using an enclosed bag having a sealable opening to allow an amount of said material to be placed in said enclosed bag such that there is headspace above said material. Process systems having emissions include spray dryers, mixers, fluid bed dryers and coolers, and storage tanks. All of these systems are closed systems, and as such have dynamic air flow properties. Applicant maintains that Applicant's claims must be read in light of the specification.

Hemphill teaches a cooking grease disposal bag. Hemphill does not teach or suggest a kit for measuring volatile organic compounds produced in a process system

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having emissions as provided by way of Applicant's invention. Further, Hemphill does not teach or suggest spray bed dryers, fluid bed dryers, or storage tank systems having emissions, nor does Hemphill teach or suggest volatile organic compounds being emitted in any system. In the Office Action dated June 22, 2006, the Examiner has admitted that Hemphill does not teach specific instructions with regard to sampling and analyzing.

Applicant maintains Hemphill is non-analogous art, and directs the Examiner's attention to the following:

Two criteria for determining whether prior art is analogous are (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 23 U.S.P.Q. 2d 1058, 1060 (Fed. Cir. 1992).

As non-analogous art, the discussion of cooking grease disposal bags in Hemphill is not within the field of the inventor's endeavor in the instant application. As stated earlier, Applicant maintains the current rejection of Claims 23-31 over Hemphill is analogous to making a rejection of Claims 23-31 over any resealable bag. There simply is no teaching or suggestion in Hemphill of Applicant's kit for measuring VOCs in a process system having emissions as Applicant has claimed.

Contrary to the Examiner's assertion, Hemphill does not teach a kit comprising a bag and instructions to use the bag in the process as claimed. The sealable bag and Hemphill do not constitute a kit. The Webster Online Dictionary defines a kit as "a packaged collection of related material". The Examiner provides no evidence that a copy of the '845 patent will be packaged with the sealable bag, or that the sealable bag will even be marked with the corresponding patent number. There is no indication that a skilled person using the sealable bag would be directed to Hemphill for instruction.

Even if Hemphill and the sealable bag do constitute a kit as alleged by the Examiner, Hemphill fails to disclose use of the kit in the process as set forth in the plain

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language of Claims 23-31. This issue was addressed in an appellate opinion of copending application No. 09/806,274, wherein the Board stated that "the preambular language must be given weight as a claim limitation which characterizes the claimed kit with respect to the 'instructions' contained therein as set forth in the body of the claim." *Ex parte Wayne Edward Beimesch*, decision of the Board of Patent Appeals and Interferences, Patent Application No. 09/806,274, Appeal No. 2004-0829, page 7, citing *In re Stencil*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). The '845 patent fails to teach or suggest using the sealable bag to sample materials from the claimed processes, which, according to the Board, is a limitation of the rejected claims.

The Examiner has directed Applicant to *In re Ngai*, wherein the CAFC decided that the content of the instructions in a kit claim needed to be functionally related to the kit.

Representative claim language from Applicant's invention as claimed which demonstrate the functional relationship of the bag to the instructions is as follows:

- ... (a) an enclosed bag having a sealable opening to allow an amount of said material to be placed in said enclosed bag such that there is headspace above said material; and
- (b) instructions for analyzing samples from said headspace in said enclosed bag, thereby providing said volatile organic compounds of said material.

The language in Applicant's representative claim functionally relates the kit, the instructions, and the VOC material to be so measured. Applicant therefore asserts that *In re Ngai* is not applicable.

To anticipate a claim, the '845 patent must teach every element of the claim and "the identical invention must be shown in as complete detail as contained in the ... claim." MPEP 2131 citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). All elements of Applicant's invention have not been

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provided by Hemphill. A *prima facie* case of anticipation is not supported. Applicant requests withdrawal of the rejection.

Rejections Under 35 U.S.C. § 103(a)

Claims 11-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "the applicant's admitted prior art" in view of U.S. Patent No. 5,140,845 to Robbins, U.S. Patent No. 5,809,664 to Legros *et al.*, Chemical Principles to Masterton, and EPA Method AP-42. Applicant respectfully submits this rejection has been rendered moot in light of the instant amendment wherein Claims 11-22 have been cancelled. Applicant requests withdrawal of the rejection.

Claims 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "the applicant's admitted prior art" in view of U.S. Patent No. 5,140,845 to Robbins, U.S. Patent No. 5,809,664 to Legros *et al.*, Chemical Principles to Masterton, EPA Method AP-42, U.S. Patent No. 5,352,674 to Cummings, and U.S. Patent No. 5,174,163 to Gussman *et al.* Applicant respectfully submits this rejection has been rendered moot in light of the instant amendment wherein Claims 35 and 36 have been cancelled. Applicant requests withdrawal of the rejection.

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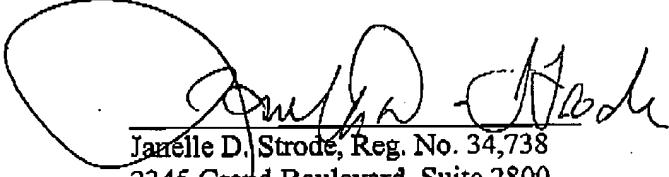
Conclusion

Applicant respectfully requests withdrawal of all rejections of Claims 22-34.

Should the Examiner believe that any issues remain outstanding, the Examiner is requested to call Applicant's undersigned attorney in an effort to resolve such issues and advance this application to issue.

Respectfully submitted,

LATHROP & GAGE L.C.



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